

Serial No. 10/736,922  
60246-223; 10692IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant: Wei  
Serial No.: 10/736,922  
Filed: December 16, 2003  
Group Art Unit: 1753  
Examiner: Mayekar, Kishor  
Title: BIFUNCTIONAL LAYERED  
PHOTOCATALYST/THERMOCATALYST FOR IMPROVING  
INDOOR AIR QUALITY

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REPLY BRIEF

Dear Sir:

The following remarks are in reply to the Examiner's Answer dated 20 December 2007. The Appeal Brief fee has already been paid. Any additional fees or credits may be charged or applied to Deposit Account No. 03-0835 in the name of Carrier Corporation.

REMARKS

Respectfully, the Examiner's Answer raises numerous additional issues that require some brief response as follows.

Appellant acknowledges and appreciates the Examiner's withdrawal of the rejections of claim 47 under the first and second paragraphs of §112.

Regarding Appellant's arguments under sections III, V(ii), VI(ii) and VI(iii) of the Appeal Brief, the Examiner responds that the MPEP section cited by Appellant with regard to "design choice" does not apply in the rejections. This was Appellant's point. Unless the Examiner's reliance on "design choice" meets the requirements of the cited MPEP section, the Examiner must provide

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explicit reasoning to support a conclusion of obviousness. Merely stating that the claims are obvious based on “design choice” does not amount to the requisite explicit reasoning. See *KSR International Co. v. Teleflex Inc.* \_\_ U.S. \_\_, 127 S.Ct. 1727, 82 U.S.P.Q.2d 1385 (2007) (“the reasoning should be made explicit”).

Regarding Appellant’s argument under section IV of the Appeal Brief, the Examiner responds that the rejection is not conclusory. However, merely stating that something is obviousness because it “would be within the level of ordinary skill in the art” appears to be conclusory because there is no reasoning given with regard to why one of ordinary skill in the art would be prompted to combine the reference as proposed or whether one would expect achieve some benefit from the combination.

Regarding Appellant’s argument under section V(i) of the Appeal Brief, the Examiner responds that the rejection establishes motivation. However, the Examiner appears to merely recite generalizations from each of the cited references without regard to the particular elements of the claims. For instance, the claims recite a container, while the rejection does not even mention a container or any reason for modifying the base reference to include a container.

Regarding Appellant’s argument under section VI(i) of the Appeal Brief, the Examiner responds that the references provide motivation that would be known outside of Applicant’s disclosure. Respectfully, Appellant disagrees because the given motivation does not even consider all of the claimed elements. For instance, the claims relate to the location of a substrate relative to an inlet. However, the given motivation does not even mention an inlet. Therefore, the rejection appears to be relying on the disclosure of the present application as a roadmap for modifying the cited references.

Regarding Appellant’s argument under sections VI(ii) and VI(iii) of the Appeal Brief, the Examiner points to a lack of unexpected results for maintaining the rejections. Appellant notes that there is no burden on Applicant to establish unexpected results when the rejections do not establish *prima facie* obviousness.

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CLOSING

For all of the reasons set forth above, and the reasons set forth in Appellant's Appeal Brief, the rejection of the claims is improper and should be reversed.

Respectfully Submitted,

  
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Dated: February 18, 2008

CERTIFICATE OF TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office, fax number (571) 273-8300, on February 18, 2008.

  
Laura Combs